

Notice of Allowability

Application No.

10/821,623

Examiner

Thong Q. Nguyen

Applicant(s)

BIHR ET AL.

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment of 12/22/06 and the interview of 3/26/07.
2. ☒ The allowed claim(s) is/are 1, 7-13 and 43-45 which are renumbered as claims 1-11.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 3/26/2007.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

THONG NGUYEN
PRIMARY EXAMINER

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment filed on 12/22/2006. It is noted that in the amendment, applicant has made changes to the specification, the drawings and the claims. Regarding to the claims, applicant has amended claims 1, 7-8, 43-44 and 45 and canceled claims 2-6 and 42. The pending claims are claims 1, 7-41 and 43-45.

Election/Restrictions

2. Claim 1 is allowable. The restriction requirement among the species, as set forth in the Office action mailed on 12/22/2005, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 8, 10 and 13, directed to the prism and the arrangement of lens elements, are no longer withdrawn from consideration because the claims require all the limitations of an allowable claim. However, claims 14-40, directed to different species of the structure of the inventive device, are still withdrawn from consideration because the claims do not require all the limitations of an allowable claim.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

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Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. As a result, the claims 1, 7-13, 41, 43-44 and 45/(1, 7-13, 41, 43 and 44) are examined in this Office action and claims 14-40 and 45/(14-40) have been withdrawn from further consideration as directed to non-elected species.

Drawings

4. The replacement sheets contained six sheets of corrected figures 1-2, 4-5, 7-8 and 10-12 were received on 12/22/06 and these replacement sheets have been approved by the examiner. As a result, the application now contains four sheets of figures 3, 6, 9 and 13-14 as filed on 4/9/2004 and six sheets of figures 1-2, 4-5, 7-8 and 10-12 as filed on 12/22/2006.

5. The objections to the drawings as set forth in the previous Office action are overcome by the amendments to the drawings and the claims as filed in the amendment of 12/22/2006.

Specification

6. The lengthy specification which was amended by the amendment of 12/22/2006 has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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7. The objections to the specification as set forth in the previous Office action is overcome by the amendments to the drawings and the claims as filed in the amendment of 12/22/2006.

Claim Objections

8. The objections to claims 1-2, 4, 7, 41, 44 and 45 as set forth in the previous Office action are overcome by the amendments to claims 1, 7-8, 43-45 and the cancellation of claims 2-6 and 42.

EXAMINER'S AMENDMENT

9. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Edward M. Kriegsman on 3/26/2007.

The application has been amended as follows:

In the claims:

- a) CANCELED CLAIMS 14-41; and
- b) Claim 45: on line 2, changed "claims 1 or 7 to 44" to
--claims 1, 7-13, 43 or 44--.

Allowable Subject Matter

- 10. Claims 1, 7-13 and 43-45 are allowed.
- 11. The following is an examiner's statement of reasons for allowance:

The tilting system having an objective device and a set of prism elements as recited in each of the independent claims 1 and 7 is patentable with respect to the cited art, in particular, the U.S. Patent Nos. 4,643,541; 5,822,114; 4,652,094; and 5,543,962 by the limitations related to the structure of the tilting system. It is noted that while a tilting system having prisms and lenses is disclosed in the art as can be seen in each of the mentioned U.S. patents; however, the mentioned Patents do not disclose a tilting system having the following features recited in each of the present claims 1 and 7: First, an 180° prism arranged crosswise to an extended position of the tilting system; Second, at least one deviating prism disposed upstream and/or downstream of the 180° prism; Third, the 180° prism and the deviating prisms rotate about two rotational axes perpendicular to the direction of light entering the tilting system; Fourth, the tilting system has two beam paths and a device formed as a lens system for adjusting the distance between the two light paths; and Fifth, the lens system is provided in at least one rotation axis about which the 180° prism and the at least one deviating prism are rotated related to one another.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

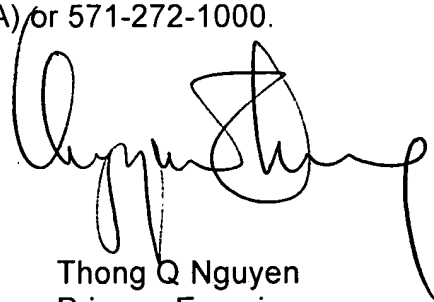
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Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



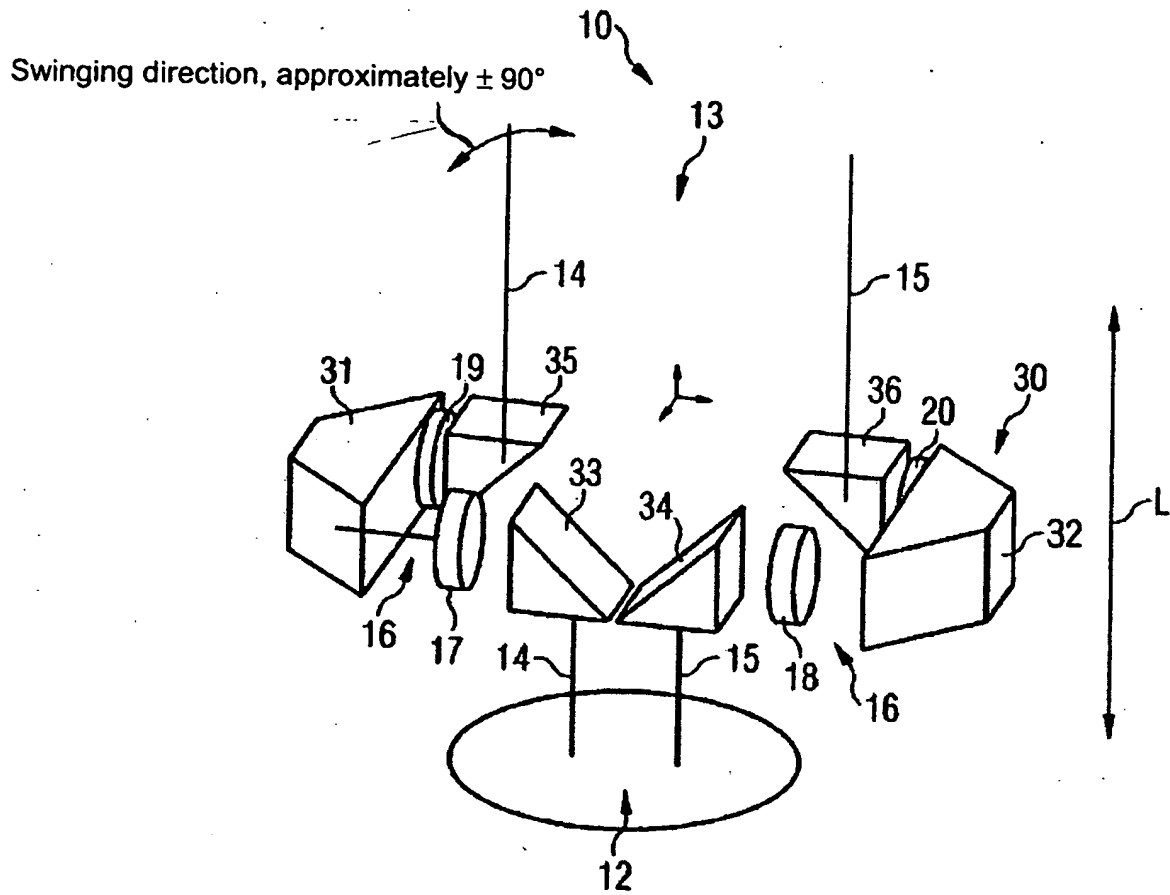
Thong Q. Nguyen
Primary Examiner
Art Unit 2872

Entry approved
3/23/07



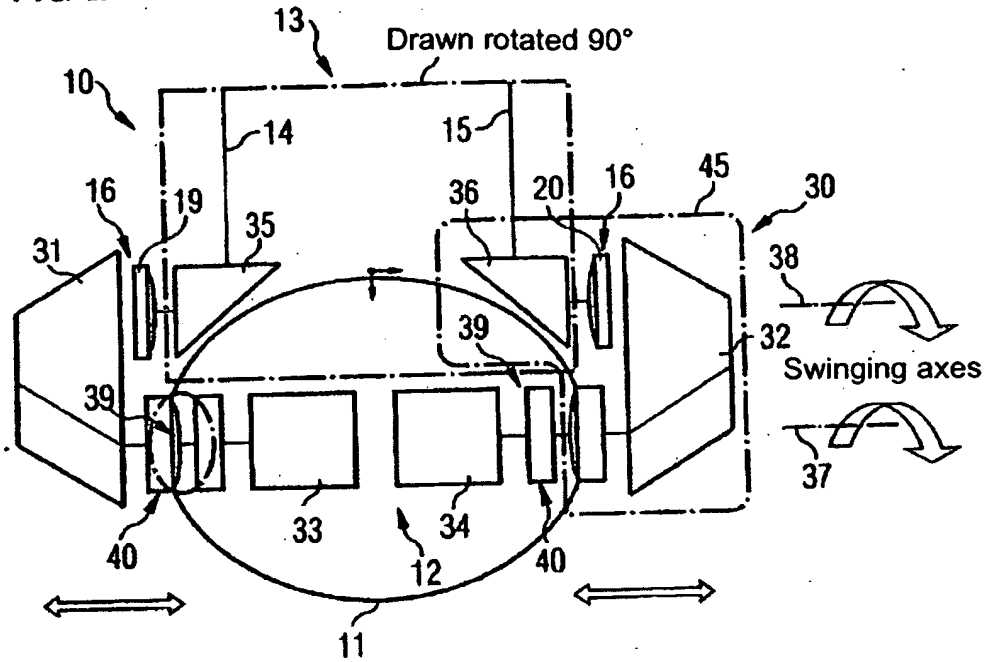
REPLACEMENT SHEET

FIG 1

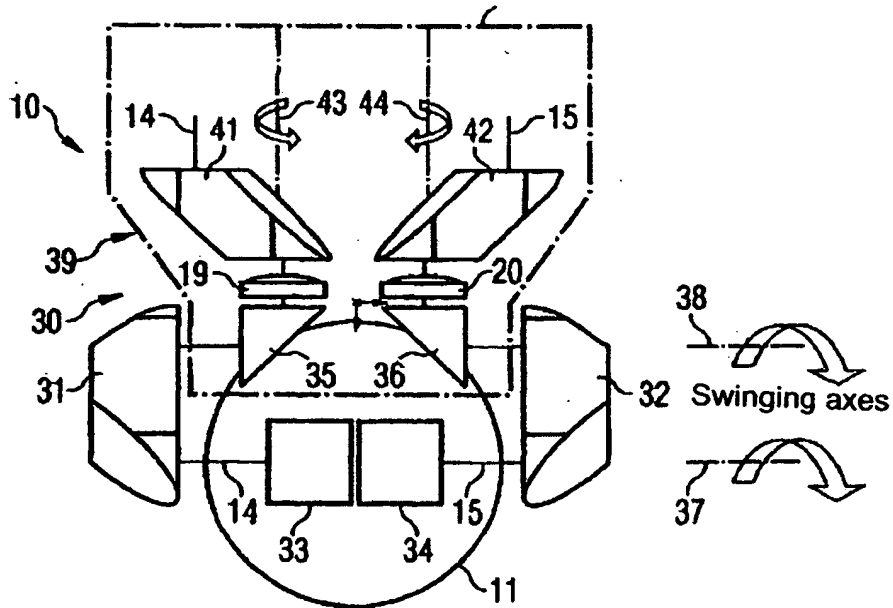


*For key approval
Use
3/25/00*

FIG 2

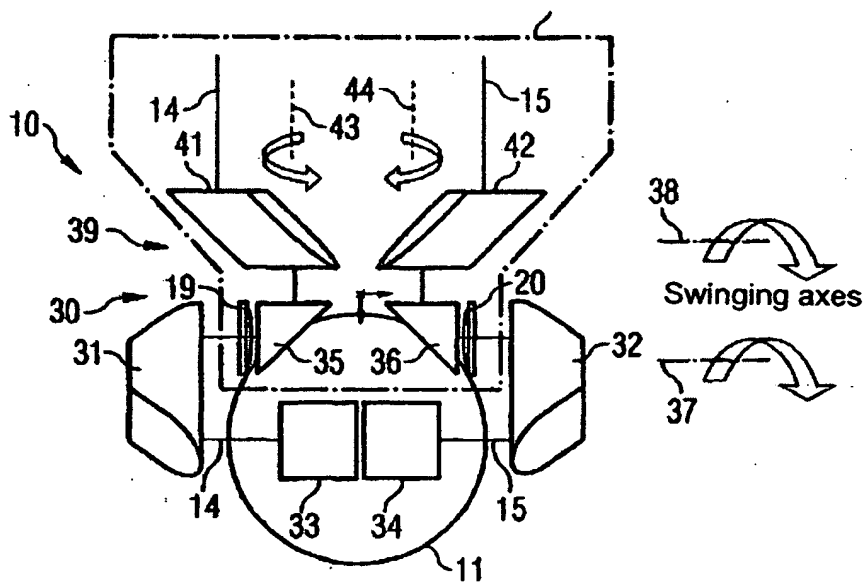


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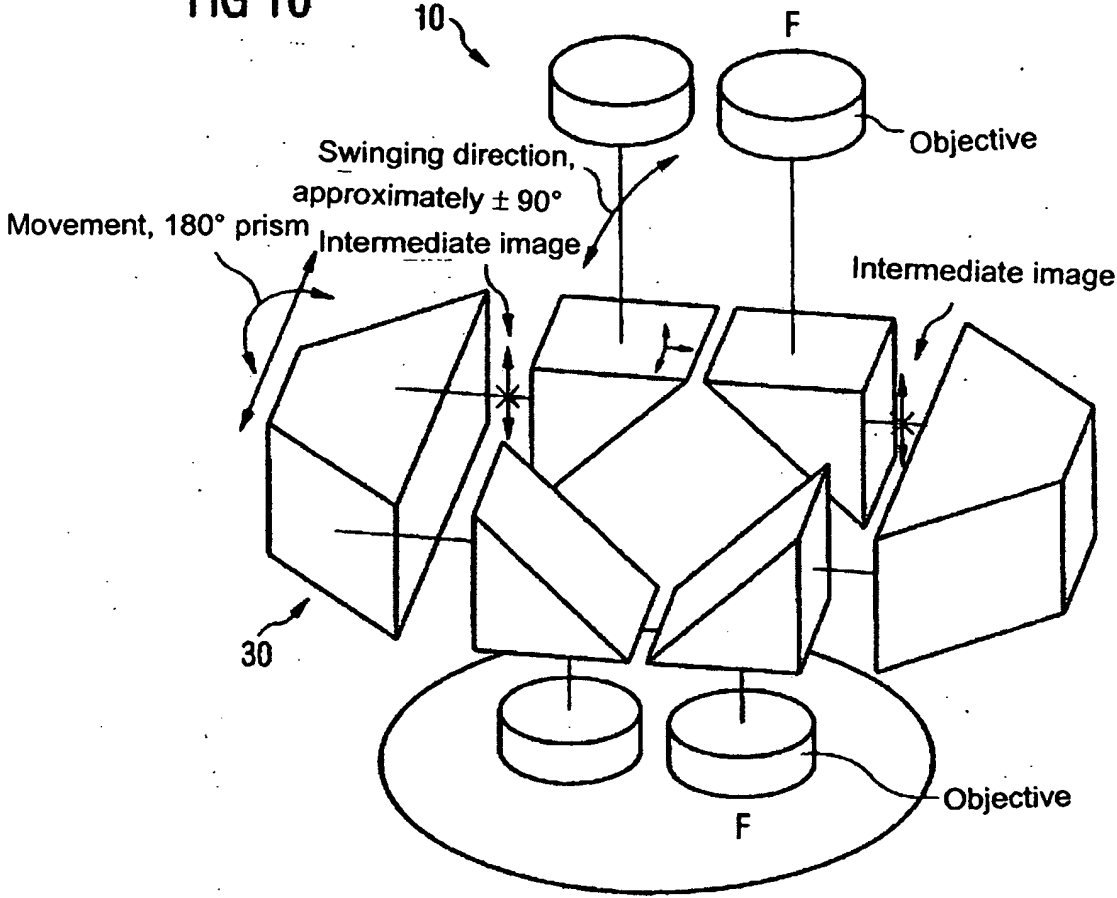
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FIG 10



*En bay appm
2007
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FIG 11

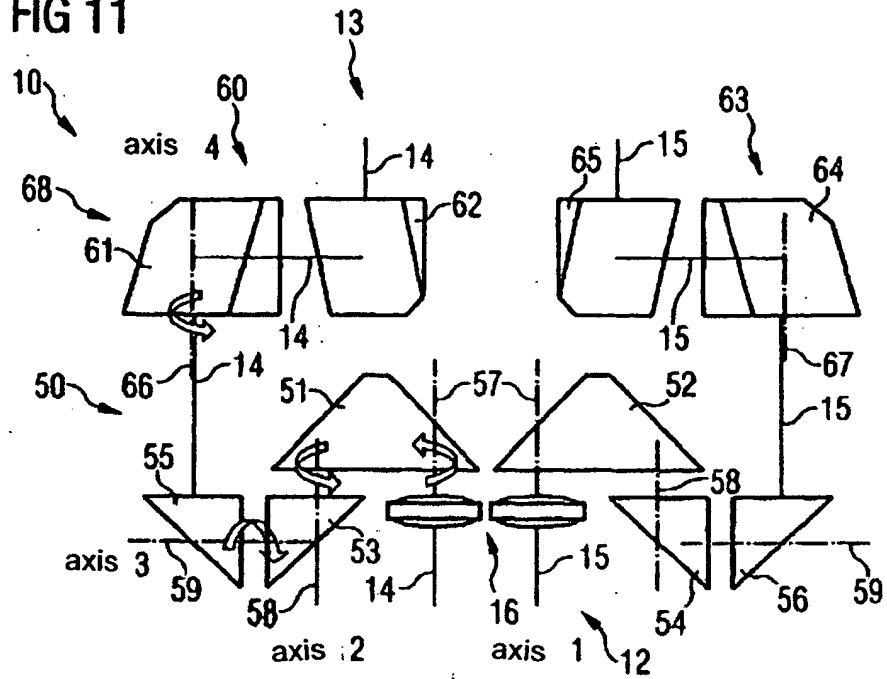


FIG 12

